

Appl. No.: 10/789,252
Art Unit: 3711 Docket No.: B04-06
Reply to Office Action of November 3, 2004

REMARKS

Claims 1-22 are pending in the application for the Examiner's review and consideration. Independent claim 1 has been amended to recite graphite nanostructures. Claim 3 has been amended to recite nanosheets. Support for the amended elements is found in the Specification, at least on page 3, line 26 - page 4, line 2. No new matter has been added by these amendments.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claim 3 was rejected under 35 U.S.C. § 112, second paragraph. The Examiner alleges that the recitation of the nanostructures further comprising layered planes of graphite is indefinite. Applicants disagree. Applicants have amended claim 3 to further describe the layered planes of graphite as being nanosheets. Support may be found at least in the specification at page 4, lines 1-2. As described in the specification, nanostructures include graphite solids measured in micron (10^{-6} meter), nanometer (10^{-9} meter) or Angstrom (10^{-10} meter), while nanosheets are layered planes of graphite of a similar size.

The rejection under 35 U.S.C. § 112, second paragraph, is therefore believed to have been overcome. Applicants respectfully request reconsideration and withdrawal thereof.

Rejection Over U.S. Patent No. 6,561,928

Claims 1, 2, 15, 16 and 17 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,561,928 to Binette *et al.* ("Binette"). Binette is generally directed to a golf ball with a multi-layer construction.

For claims to be rejected under 35 U.S.C. § 102(e), each and every element as set forth in the claims of the present invention must be found, either expressly or inherently, in a single prior art reference. Applicants respectfully submit that Binette does not disclose all the elements of the claimed invention.

Binette fails to disclose or suggest using graphite in nanostructure form. As discussed in the Background of the present application, while it has been known to include fillers, such as graphite, in the inner cover or cover layers, these fillers have not been provided in nanostructure form. (See specification, page 1, line 12 – page 2, line 9). For example, as known to those of skill in the art, graphite and other materials used for fillers have been typically provided in chopped fiber or powder form. These forms are much larger than graphite provided in nanostructure form.

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Applicants submit that Binette fails to teach or suggest use of graphite in a nanostructure form as defined in the present specification as graphite solids measured in units of micron (10^{-6} meter), nanometer (10^{-9} meter) or Angstrom (10^{-10} meter).

Accordingly, amended independent claim 1 is believed to be in condition for allowance for at least the reasons set forth above. Moreover, the remaining claims 2, 15, 16 and 17 depend from claim 1 discussed above and add additional features. These claims are believed to be patentable for the totality of the claimed inventions therein and by virtue of their dependence from independent claim 1. As such, Applicants respectfully request that the rejection under 35 U.S.C. § 102(e) be reconsidered and withdrawn.

Rejection Under Obviousness-Type Double Patenting

Claims 1-22 were rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-52 of U.S. Patent No. 6,802,784. A Terminal Disclaimer is submitted herewith and reconsideration and withdrawal of this rejection is respectfully requested. Claims 1-22 should now be in condition for allowance.

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Conclusion

Based on the remarks set forth above, Applicants believe that all of the rejections have been overcome and the claims of the subject application are in condition for allowance. Should the Examiner have any further concerns or believe that a discussion with the Applicants' attorney would further the prosecution of this application, the Examiner is encouraged to call the attorney at the number below.

A fee of \$130 is due for the submission of the Terminal Disclaimer. A supplemental Information Disclosure Statement has also been submitted herewith and a fee is due for this submission. A fee sheet is submitted herewith requesting that the fees be charged to Applicant's deposit account. Please charge any other required fees to Acushnet Company Deposit Account No. 502309.

Respectfully submitted,

1/28/05
Date


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